

REMARKS

Entry of the present amendment and favorable reconsideration and allowance of this application are requested.

1. Discussion of Amendments

By way of the amendment instructions above, independent claims 1 and 7 have been revised so as to emphasize that the poly(alkylene oxide) polyol has an unsaturation content, being the total content of vinyl and allyl groups, of less than 25 meq per kg poly(alkylene oxide) polyol.

As such, claim 16 has been canceled as redundant. In addition, claims 23 and 24 were presented so as to be dependent from claims 1 and 7, respectively, and define the unsaturation content as 15 meq per kg and 20 meq per kg poly(alkylene oxide) polyol as described on page 11, penultimate paragraph bridging page 12 of the specification.

Claims 5 and 6 were revised for purposes of conformity and clarity.

In order to prevent redundancy, claims 19 and 20 were amended so as to recite the preferred ranges noted on page 10, lines 15-16 of the specification.

Therefore, following entry of this amendment, claims 1-15 and 17-22 will be pending herein for which favorable action on the merits is solicited.

2. Response to 35 USC §§102(b) and 103(a) Rejections

The inclusion of the subject matter of prior claim 16 in each of claims 1 and 7 renders moot the Examiner's rejection advance against claims 1-3, 17, 19 and 20 under 35 USC §102(b) or alternatively under 35 USC §103(a) based on Bonte et al (USP 6,380,290) as well as the rejection advanced against claims 6-10, 12-13, 18, and 21-22 under 35 USC §103(a) based on Bonte et al.

Therefore, the only issue remaining to be resolved in this application is the Examiner's rejection of prior claims 4-5, 11 and 16 under 35 USC §103(a) based on

Bonte et al in view of Smith (USPT 4,562,232). As will become evident from the following discussion, such a rejection is inappropriate against the claims now pending in this application.

In formulating his rejection, the Examiner hypothesizes that, since Smith discloses a molecular weight of up to 12,000, then necessarily "...a very low amount of unsaturation is present otherwise the reaction stops due to the presence of unsaturation and the MW remains low." (Official Action at page 9, lines 12-15) Applicants note however that such a hypothesis is in error.

Specifically, it is erroneous to assume that high molecular weight segments would "inherently" possess a low level of unsaturation. In this regard, high molecular weight segments that are produced with conventional production methods are known to have a high level of unsaturation as explained on page 5, lines 2-21 of the originally filed specification. There it is explained that conventional polyols can have lowered unsaturated end groups by subsequent hydrolysis of the vinyl and propenyl end groups under acidic conditions or by using different polymerization catalysts, i.e., zinc hexacyanocobaltate complexes. Thus, the Examiner's speculative statements are not factually accurate.¹

Smith does not disclose or suggest at all lowering the unsaturation level and/or any method to achieve such lowered unsaturation levels. Thus, contrary to the Examiner's assertion, if in fact Smith obtains high molecular weight products, such products would be those customarily and conventionally known to the ordinarily skilled person – i.e., products having a high – not low – unsaturation level. Most certainly there would be no impetus at all to combine Smith with Bonte et al and even if combined the products of the present invention would not be obtained.

Applicants further note that Smith does not in fact actually contemplate high molecular weight products as his examples only evidence customary lower molecular

¹ Factual speculation has been uniformly condemned by the Court. See, *In re Katzaschmann*, 146 USPQ 66 (CCPA 1965).

weights of 2000. Thus, even though there may be some naked mention of an exceptionally broad molecular weight range in Smith between 350 and 12,000, such a disclosure does not render the present invention "obvious" under 35 USC §103(a) especially in light of the factual evidence provided by page 5, lines 2-21 of the specification and the erroneous nature of the Examiner's speculation.

Simply stated, Smith, like the other references of record herein, is silent regarding the presence or the level of unsaturation and the influence of such level of unsaturations. Moreover, as has been explained above, such silence does not justify a conclusion that the higher the molecular weight, the lesser the amount of unsaturations. To continue with such a line of reasoning would therefore amount to reversible error.

Withdrawal of the rejection advanced under 35 USC §103(a) based on Bonte et al and Smith is therefore also in order.

3. Fee Authorization

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

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